

REMARKS

In the Office Action, the Examiner rejected claims 1-6 and 10-15 and objected to claims 7-9, 16, and 17 as being dependent upon rejected based claims. The Examiner further indicated that claims 7-9 and 16-17 would be allowable if rewritten in independent form including all of the limitations of the base and intervening claims. Applicants thank the Examiner for the indication of allowable subject matter. By this paper, Applicants have added claims 92-115. These claims do not add any new matter. Further, the new claims are consistent with the claims restricted to Group I by the Examiner and elected by Applicants in the Response to Election Requirement filed on October 15, 2004. Upon entry of these new claims, claims 1-17 and 92-115 are pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1 and 10 under 35 U.S.C. § 102(e) as being anticipated by Imbert de Tremiolles et al. (U.S. Patent No. 6,715,104). Applicants respectfully traverse these rejections.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas*

Powder v. E.I. du Pont, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite *even one element not found* in the cited reference, the reference does not anticipate the claimed invention.

Deficiencies of the Rejection

Independent claim 1 recites “a memory system comprising a plurality of memory cartridges operably coupled to the host/data controller, *each memory cartridge comprising an operation indicator*.” (Emphasis added). The Examiner appears to be correlating the recited “memory cartridges” and “operation indicator” with the “memory cards” and “memory card assignment table” of the Imbert reference. Regardless of the correctness of the Examiner’s characterization of the Imbert reference, the reference fails to disclose the features recited in the present claims.

The Imbert reference discloses an apparatus wherein a “[m]emory card assignment table 260 is used to set or get the status of each memory card.” Imbert, col. 4, lines 32-33; *see* also Fig. 3. This memory card assignment table 260 is stored *within a memory controller* 120. Imbert, col. 3, lines 35-36. As indicated in Fig. 1, the card assignment table 260 is not on the memory cards 100-1 to 100-n. In other words, the memory card assignment table 260 in the Imbert reference is clearly *stored in the controller and not on the memory cards* 100-1 to 100-n. *See* Imbert, col. 4, lines 20-43. Accordingly, it cannot be said that the memory cards 100-1 to 100-n of the Imbert reference *comprise* the card assignment table 260. As such, the Imbert reference does not disclose the above-described features of independent claim 1 and cannot possibly anticipate the recited subject matter. Accordingly, Applicants request withdrawal of the Examiner’s rejections and allowance of independent claim 1 and the claims that depend therefrom.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 11 and 12 under 35 U.S.C. § 103(a), as being unpatentable over the Imbert reference in view an excerpt from a Microsoft dictionary. Further, the Examiner rejected claims 2-6 under 35 U.S.C. § 103(a), as being unpatentable over the Imbert reference in view of Olarig (U.S. Patent No. 6,098,132) and rejected claims 13-15 under 35 U.S.C. § 103(a), as being unpatentable over the Imbert reference and the Microsoft dictionary as applied to claim 11, in further view of the Olarig reference. Applicants respectfully traverse these rejections.

Legal Precedent

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). Moreover, the Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited

references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). A statement that the proposed modification would have been “*well within the ordinary skill of the art*” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Second, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The Federal Circuit has consistently warned against using hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Claims 11 and 12

Applicants respectfully assert that several features of independent claim 11 are not disclosed by the cited reference. For example, independent claim 11 recites a method comprising “initiating a system interrupt signal, *the type of system interrupt signal being dependent on the operational status of the memory system.*” (Emphasis added) The Examiner’s rejection of claim 11 under 35 U.S.C. § 103 is flawed because the cited references do not teach or suggest, alone or together, this claim feature. The Imbert reference is directed to a system that detects hard failures in a memory card and “sends a message through bus 250 to the computer to inform the user which memory card needs to be replaced.” Imbert, col. 4, lines 29-32. The Imbert reference makes clear that signals are only *generated when a hard failure occurs* because “errors due to soft errors disappear when the data is rewritten.” Imbert, col. 4, lines 21-23 (cited by the Examiner in the Office Action). As such, the Imbert reference cannot disclose “initiating a system interrupt signal the type of interrupt signal being dependent on the operational status of the memory system,” as recited in claim 11, because the Imbert reference only generates a *single type of signal*. Accordingly, Applicants respectfully request the withdrawal of the Examiner’s rejection under 35 U.S.C. §103(a) and the allowance of claims 11-17.

Moreover, the Examiner has not presented any *objective evidence* of the requisite motivation or suggestion to modify the Imbert reference that could lead the ordinary artisan to make the modifications that the Examiner believes “would be obvious.” In fact, the Examiner does not even assert that the Imbert reference contains any motivation or suggestion to modify the device disclosed therein in the manner recited in the present claims. *See* Office Action, page 4, lines 3-15. As such, Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness and request withdrawal of the obviousness rejections against claim 11 and the claims that depend therefrom.

Further, a *prima facie* case of obviousness clearly cannot be established by simply asserting, as the Examiner has, that a recited feature is obvious. *See* Office Action, page 4, lines 3-15. Rather, the Examiner's unsupported allegation of obviousness suggests that the Examiner has, at best, used the teachings of the application as a road map to reach the pending claims. Applicants respectfully remind the Examiner that the Federal Circuit has warned that the Examiner must not "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Therefore, without any proper supporting evidence, the Examiner's summary statement regarding what "would have been obvious" is, again at best, impermissible hindsight reconstruction. For this additional reason, Applicants respectfully request withdrawal of the Section 103 rejections against independent claim 11 and the claims that depend therefrom.

In closing, Applicants reiterate that the Examiner bears the burden of establishing a *prima facie* case of obviousness. With that in mind, Applicants respectfully assert that the foregoing remarks clearly establish that the Examiner has failed to satisfy the evidentiary thresholds with regard to independent claim 11. Accordingly, Applicants respectfully assert that independent claim 11 and the claims that depend therefrom, are patentable over the cited references and are thus in condition for allowance. For these additional reasons, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 11-17.

Claims 2-6 and 13-15

As stated above, the Examiner rejected claims 2-6 as obvious over the Imbert reference in view of a Microsoft dictionary and claims 13-15 as obvious over the Imbert reference and the Microsoft dictionary and further view of the Olarig reference. Applicants respectfully submit that claims 2-6 and 13-15 are allowable based on their dependencies on claims 1 and 11, because neither the Olarig reference nor Microsoft dictionary cure the above-described deficiencies in the Imbert reference. For at least these reasons, claims 2-6 and 13-15 are believed to be allowable over the cited references taken alone or in conjunction with each other. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 2-6 and 13-15.

New Claims


Applicants respectfully request that new claims 92-115 be considered. The new claims are fully supported by the specification and consistent with the election filed on October 15, 2004. Applicants respectfully submit that the references of record do not disclose or suggest the subject matter recited in new claims 92-115. Specifically, new independent claims 92, 101, and 110 recite subject matter from claims 7 and 16 that the Examiner has indicated as allowable. For example, claim 92 recites a system comprising “a controller operably coupled to the memory cartridge and configured to generate a low priority interrupt if an error detection component detects a memory error and the memory cartridge is operational,” claim 101 recites a method comprising “initiating a low priority system interrupt signal if the memory system is operating in the redundant mode,” and claim 110 recites a “tangible machine readable medium comprising...code adapted to initiate a low priority system interrupt signal if the memory system is in an operational state.” Accordingly, Applicants respectfully submit that new claims 92-115 are allowable over the cited references.

Conclusion

In view of the remarks set forth above, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

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Respectfully submitted,


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